

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Raymond G. Schuder et al. Art Unit : 3722
Serial No. : 10/820,649 Examiner : Gates, Eric Andrew
Filed : 4/7/04 Confirmation No.: 8492
Title : SYSTEMS AND METHODS OF ATTACHING A COVER TO A TEXT
BODY

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

I. Introduction

Claims 9-13, 21-30, and 36-39 are pending. Of these claims, claims 9-13, 21-24, 27-30, and 36-39 stand rejected, and claims 25 and 26 stand allowed.

Claims 1-8, 14-20, and 31-35 have been canceled.

Claims 9-12, 21-24, 27-29, and 36-39 stand rejected under 35 U.S.C. § 103(a) over Leclerc (U.S. 5,261,769) in view of Ensign (U.S. 6,422,281).

Claims 9-12, 21-24, 27-29, and 36-39 stand rejected under 35 U.S.C. § 103(a) over Leclerc (U.S. 5,261,769) in view of Rossini (U.S. 5,261,996).

Claims 13 and 30 stand rejected under 35 U.S.C. § 103(a) over Leclerc (U.S. 5,261,769) in view of Ensign (U.S. 6,422,281) and Rossini (U.S. 5,261,996).

II. Claim rejections under 35 U.S.C. § 103(a)

A. Rejection of claims 9-12, 21-24, 27-29, and 36-39 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign

I. Independent claim 9

In the Appeal Brief, Appellants explained that the rejection of independent claim 9 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign should be withdrawn because Leclerc in view of Ensign does not disclose or suggest all the elements of the claimed

CERTIFICATE OF TRANSMISSION

I hereby certify that this document is being transmitted to the Patent and Trademark Office via electronic filing on the date shown below

Apr. 28, 2010
Date of Transmission

Edouard Garcia, Reg. No. 38,461
(Signature of person mailing papers)

Edouard Garcia
(Typed or printed name of person mailing papers)

invention (see pages 5-10) and because at the time the invention was made there was not any apparent reason to combine the teachings of Leclerc and Ensign in the manner proposed by the Examiner (see pages 10-11).

a. The cited references do not disclose or suggest the "adhesive dispenser" element of claim 9

The rejection of independent claim 9 is premised on the Examiner's assertion that Ensign discloses an adhesive dispenser that is configured "to replace the hot melt glue guns 50/82" and/or apply "two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine" (see § 3 on pages 3-4 of the Office action).

As explained on pages 6-7 of the Appeal Brief, Ensign discloses a manually-operated adhesive transfer apparatus that is purposefully designed to apply pressure-sensitive adhesive over an entire surface of a selected substrate so that, at some later time, the selected substrate can be peeled off the transfer substrate for adherence to a desired contact surface (see, e.g., col. 1, lines 59-61, col. 2, lines 7-10, and col. 11, lines 4-29 and lines 40-65; FIG. 13).

The Examiner has responded to this explanation as follows (see page 17 of the Answer; emphasis added):

... However, it is noted that Ensign teaches in column 15, line 56 to column 16, line 11, that "the principles of the present invention are not limited by size and the apparatus of a large size for industry heavy use applications", implying that the invention of Ensign is capable of being used for large scale applications beyond the scope of the embodiment in the drawings, and that while a preferred embodiment of the invention teaches a substrate with a similar width as the mask instead of a substrate of greater width, "this feature is preferred and not necessary and should not be considered to limit the invention". One of ordinary skill in the art at the time of the invention would have found it obvious to have modified the teachings of Ensign to obtain a bookbinding system as claimed in independent claim 9 because the substitution of one known element for another would have yielded predictable results, as the combination merely relies upon replacing the hot melt adhesive system with a properly sized pressure sensitive adhesive system that supplies two spaced apart adhesive films instead of one for the purpose of supplying adhesive on both sides of the book block spine.

As explained on page 9 of the Appeal Brief, however, neither Ensign's statement that the principles of his invention are not limited by size (col. 15, lines 57-61), nor Ensign's statement that the feature of the lateral width of the opening 376 through which the substrate is fed being slightly narrower than the mask and transfer substrates 344, 346 is preferred and not necessary and should not be considered to limit the invention (col. 15, line 62 – col. 16, line 11) constitutes a disclosure that would have led one skilled in the art "to replace the hot melt glue guns 50/82" and/or apply "two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine" with Ensign's adhesive transfer apparatus, which applies pressure-sensitive adhesive over the selected substrate and the adhesive mask substrate eliminates excess adhesive that extends beyond the edges of the selected substrate (see, e.g., col. 2, lines 1-31, and col. 11, lines 62-67) so that, at some later time, the selected substrate can be peeled off the transfer substrate for adherence to a desired contact surface (see, e.g., col. 1, lines 59-61, and col. 11, lines 52-65). Indeed, neither of the cited statements of Ensign relate to the replacement of Leclerc's hot melt glue guns 50/82 nor to the application of apply "two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine. Instead, these statements relate to the overall size of Ensign's system and to the lateral width of the opening 376 through which the substrate is fed. The mere fact that Ensign's adhesive mask substrate based adhesive transfer system and Leclerc's hot melt glue guns 50/82 were "known" does not constitute an apparent reason for one skilled in the art to replace one with the other.

In addition, as explained on pages 7-8 of the Appeal Brief, the Examiner's proposed modification of Leclerc's bookbinding apparatus would not result in the inventive subject matter defined in claim 9 because the side hinge areas of the cover would not be bound to the text body. The Examiner has responded to this explanation as follows (see page 18 of the Answer; emphasis added):

... However, it is noted that the appropriate embodiment is shown in figures 7 and 8, and column 3, lines 44-55 of Leclerc states that "the glue gun 50 applies a first strip of adhesive 62 (FIG. 7 and 8) to the first portion 64 of the cover 20 for covering the first side 66 of the book block 14. A glue gun 82 (FIG. 2) applies a second strip of adhesive 84 to the second portion 68 of the cover 20 for covering the second side 70 of the book block 14". Therefore Leclerc teaches that the adhesive

is used to bind the side hinge areas of the cover to the text body, and the modification using the pressure sensitive adhesive of Ensign would build on this teaching.

As explained on page 9 of the Appeal Brief, however, as shown clearly in FIGS. 7 and 8 of Leclerc, however, the adhesives 62/84 bind the crash 24/29 to the side portions 64/68 of the cover 20, but the crash 24/29 is not bound to the sides 66, 70 of the text block 70; instead, the crash 24 is bound only to the spine portion 32 of the text block 70 via roller-applied adhesive 44. Therefore, the Examiner's proposed combination of Leclerc and Ensign would not result in "an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body; and a cover binder configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover," as recited in claim 9.

b. One skilled in the art would not have had any apparent reason to combine the cited references in the manner proposed by the Examiner

On pages 9-11 of the Appeal Brief, Appellant explained that Ensign's adhesive transfer apparatus applies pressure-sensitive adhesive over the selected substrate and the adhesive mask substrate eliminates excess adhesive that extends beyond the edges of the selected substrate (see, e.g., col. 2, lines 1-31, and col. 11, lines 62-67) so that, at some later time, the selected substrate can be peeled off the transfer substrate for adherence to a desired contact surface (see, e.g., col. 1, lines 59-61, and col. 11, lines 52-65). Thus, there is no readily apparent way to configure Ensign's adhesive mask substrate based adhesive transfer apparatus such that it could "replace the hot melt glue guns 50/82" or be able to apply "two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine" as proposed by the Examiner.

The Examiner has argued that in his proposed modification of Leclerc's system (page 19 of the Answer):

... all of the mask substrate would be taken up by the take-up roll 136 in the combination as applied in the rejection of claim 9. Only the two adhesive strips and the transfer substrate 170 on top of the strips would remain on the book cover 20 of Leclerc (the modified selected substrate 186 of Ensign), the

transfer substrate then being peeled back to uncover the adhesive so that the cover could be adhered to the book block according to the teachings in column 11, lines 62-65 of Ensign.

In this proposal, however, the Examiner ignores the fact that in accordance with Ensign's express teachings the mask substrate 166 and the adhesive transfer substrate 170 are located on opposite sides of the selected substrate 186 (see, e.g., FIG. 13). In this configuration, there is no way for the mask substrate to remove all the adhesive except two strips along the side hinge areas of the cover. The Examiner's argument therefore rests on a configuration of Ensign's system that is neither disclosed nor suggested by Ensign.

On pages 10-11 of the Appeal Brief, Appellant also explained that even if it were possible to modify Ensign's adhesive transfer apparatus to be able to apply "two laterally spaced apart adhesive films" over selected portions of the cover, such a modification would have obviated the need for the key inventive element of Ensign's invention: namely, the provision of an adhesive mask substrate that automatically removes all excess adhesive that extends beyond the edges of the selected substrate so that "There is no need to handle or discard the mask substrate 166 because it is wound up on the take-up roll 136" (col. 11, lines 65-67; also see col. 2, lines 1-31). The Examiner has responded to this explanation by stating that "this argument is not persuasive because all of the mask substrate would be taken up by the take-up roll 136 in the combination as applied in the rejection of claim 9" (page 19 of the Answer). As explained above, however, in accordance with Ensign's express teachings the mask substrate 166 and the adhesive transfer substrate 170 are located on opposite sides of the selected substrate 186 (see, e.g., FIG. 13). Therefore, the mask substrate 166 would not serve any useful purpose in the modified version of Leclerc's system made-up by the Examiner.

c. Conclusion

For the reasons explained above and on pages 5-11 of the Appeal Brief, the rejection of claim 9 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign should be withdrawn.

2. Dependent claims 10-12, 21-24, 27-29, and 36-39

Each of claims 10-12, 21-24, 27-29, and 36-39 incorporates the elements of independent claim 9 and therefore is patentable over Leclerc in view of Ensign for at least the same reasons explained above.

B. Rejections of claims 9-12, 21-24, 27-29, and 36-39 over Leclerc in view of Rossini

1. Independent claim 9

In the Appeal Brief, Appellants explained that the rejection of independent claim 9 under 35 U.S.C. § 103(a) over Leclerc in view of Rossini should be withdrawn because Leclerc in view of Rossini does not disclose or suggest all the elements of the claimed invention (see pages 14-15) and because at the time the invention was made there was not any apparent reason to combine the teachings of Leclerc and Ensign in the manner proposed by the Examiner (see pages 15-16).

a. The cited references do not disclose or suggest the "adhesive dispenser" element of claim 9

The rejection of claim 9 is premised on the Examiner's position that the configuration of Rossini's applicator machine 10 described in col. 8, lines 12-34 in which the applicator machine 10 applies an "adhesive tape" to a substrate constitutes "an adhesive dispenser configured to apply a solid pressure sensitive adhesive film" that is suitable for application between a cover and the side hinge areas of a text body and subsequent use in binding the cover to the side hinge areas of the text body by applying pressure to the cover (see pages 8-9 of the Office action dated August 12, 2009).

As explained on page 14 of the Appeal Brief, however, the adhesive tape disclosed in Rossini does not constitute such a solid pressure sensitive adhesive film. In accordance with Rossini's disclosure, the adhesive tape is a web material that has a single adhesive side with a pressure sensitive adhesive or other adhesive and an overlying protective release layer 48 (see col. 8, lines 19-34). When used with such a tape, the applicator machine 10 removes protective release layer 48 and applies the exposed adhesive side of the tape to a substrate with the non-adhesive side of the tape facing away from the substrate. Applied in this way,

the adhesive tape does not constitute "a solid pressure sensitive adhesive film" that is suitable for application between a cover and the side hinge areas of a text body and subsequent use in binding the cover to the side hinge areas of the text body by applying pressure to the cover.

The Examiner has responded to this explanation as follows (page 20 of the Answer):

... However, Rossini teaches in column 6, lines 15-19 that "the strip of web material can be any tape, film, foil or the like ... ", and one of ordinary skill in the art at the time of the invention would have known to have selected a tape material having adhesive with a liner on both sides of the tape for use as a binding tape. this modification providing no unexpected results.

Neither Rossini nor Leclerc, however, discloses anything that would have led one skilled in the art "to have selected a tape material having adhesive with a liner on both sides of the tape for use as a binding tape," as proposed by the Examiner. To the contrary, in the same paragraph containing the cited language quoted by the Examiner (but inexplicably not mentioned), Rossini expressly discloses that "If the web material is an adhesive tape, such as a pressure sensitive adhesive tape, it may be necessary to remove a protective release layer from the adhesive side of the tape before feeding the tape to the wheel applicator" (col. 6, lines 20-26). Thus, in the case when the web material is a tape, Rossini discloses that the tape is a single-sided adhesive tape, not a double-sided tape as proposed by the Examiner. Moreover, such a double-sided tape would not work in Rossini's applicator machine 10 because the protective release layers would be removed from the adhesive sides of the tape before the tape is advanced to the drive and guide means 32 (see col. 8, lines 12-34), in which case the tape would undesirably adhere to the drive and guide means thereby rendering the machine 10 inoperable for its intended purpose.

In the Appeal Brief (see pages 14-15), Appellants explained that the Examiner's proposed modification of Leclerc's bookbinding apparatus would not result in the inventive subject matter defined in claim 9. In response, the Examiner relied on the rationale that he gave in response to the analogous argument presented above and in the Appeal Brief in connection with the rejection of claim 9 over Leclerc in view Ensign.

b. One skilled in the art would not have had any apparent reason to combine the cited references in the manner proposed by the Examiner

On page 16 of the Appeal Brief, Appellant explained that the motivation given by the Examiner in support of the combination of Leclerc and Ensign (i.e., "in order to be able to replace the hot melt glue guns 50/82 with a pressure sensitive adhesive system that applies a well-known alternative adhesive material") is not supported by any of the Leclerc, Rossini, or the knowledge generally available at the time the invention was made. Indeed, neither Leclerc nor Rossini discloses anything that would have led one skilled in the art to believe that the single-sided tape that is applied by Rossini's applicator machine 10 is an art recognized alternative to the hot melt glue that is applied by Leclerc's hot melt glue guns 50/82. To the contrary, Rossini's single-sided tape is incapable of binding the cover 20 to the book block 14 and therefore clearly is not an art recognized alternative to the hot melt glue that is applied by Leclerc's hot melt glue guns 50/82.

In the Answer, the Examiner has responded to this explanation by stating that "Appellant's argument on page 16 is moot as it was taught above that one of ordinary skill in the art would have selected a tape with adhesive on both sides of the tape" (page 20 of the Answer). As explained above, however, in the case when the web material is a tape, Rossini discloses that the tape is a single-sided adhesive tape, not a double-sided tape as proposed by the Examiner (col. 6, lines 20-26).

c. Conclusion

For the reasons explained above and on pages 14-16 of the Appeal Brief, the rejection of claim 9 under 35 U.S.C. § 103(a) over Leclerc in view of Rossini should be withdrawn.

2. Dependent claims 10-12, 21-24, 27-29, and 36-39

Each of claims 10-12, 21-24, 27-29, and 36-39 incorporates the elements of independent claim 9 and therefore is patentable over Leclerc in view of Rossini for at least the same reasons explained above.

C. Rejections of claims 13 and 30 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign and Rossini

1. Dependent claim 13

Claim 13 is patentable over Leclerc in view of Ensign and Rossini for the same reasons explained above in connection with independent claim 9 and explained on pages 17-18 of the Appeal Brief.

2. Independent claim 30

Independent claim 30 is patentable over Leclerc in view of Ensign and Rossini for the same reasons explained above in connection with independent claim 9 and explained on pages 18-21 of the Appeal Brief.

III. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

Respectfully submitted,

Date: April 28, 2010

/Edouard Garcia, Reg. No. 38,461/
Edouard Garcia
Reg. No. 38,461
Telephone No.: (650) 605-3532